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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,154

02/13/2006

Mitsuo Kimura

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EXAMINER

FOGARTY, CAITLIN ANNE

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

08/11/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto.phil@dlapiper.com

Office Action Summary	Application No. 10/568,154	Applicant(s) KIMURA ET AL.	
	Examiner CAITLIN FOGARTY	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 24 – 34 are pending where claims 24 and 33 have been amended.
Claims 1 – 23 and 35 have been cancelled.

Status of Previous Objections and Rejections

2. The objection to claim 24 has been withdrawn in view of the amended claims filed April 20, 2009.

The 35 U.S.C. 112 second paragraph rejection of claim 24 has been withdrawn in view of the amended claims filed April 20, 2009.

The 35 U.S.C. 103(a) rejection of claims 24 – 34 as being unpatentable over JP 2002-004009 has been maintained.

The provisional rejection of claims 24 – 34 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25, 27-29, 31, 35, 36, and 49 of copending Application No. 10/576,885 has been maintained.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 24 – 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the English machine translation of JP 2002-004009 (hereinafter JP '009) from the IDS.

JP '009 is applied to claims 24 – 34 as set forth in the December 23, 2008 Office action.

With respect to the amended features of instant claim 24, the amendments to equations (1) and (2) merely corrected a typographical error and incorporated a limitation from claim 33 and therefore did not change the scope of the claim. The rejection for claim 33 as set forth in the December 23, 2008 Office action is now applied to the amended claim 24.

The amendment to claim 33 removed a claim limitation and incorporated it into amended claim 24. Therefore, the amended claim 33 remains rejected as set forth in the December 23, 2008 Office action.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 24 – 34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 25, 27-29, 31, 35, 36, and 49 of copending Application No. 10/576,885 as set forth in the December

23, 2008 Office action. The amendment to claims 24 and 33 did not change the scope of the claims but merely incorporated a limitation from a dependent claim into an independent claim. Application No. 10/576,885 recites that the stainless seamless steel pipe has a ferrite phase at a volume fraction of 10-60% which overlaps with the instant recited range.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

7. Applicant's arguments filed April 20, 2009 have been fully considered but they are not persuasive.

Arguments are summarized as follows:

None of the examples of JP '009 refer to a percentage of ferrite.

Therefore, there is no disclosure of the presence of ferrite in any of the JP '009 inventive steels. The Applicants respectfully submit that one skilled in the art cannot have a reasonable belief that ferrite is "necessarily" present in the claimed volume fraction. There is simply too much uncertainty in the JP '009 disclosure to meet that very high burden.

Examiner's response is as follows:

The scope of JP '009 is not limited to the specific embodiments it teaches (see *In re Fracalossi* 215 USPQ 569 (CCPA 1982)). In the absence of evidence to the contrary, the Examiner maintains the position that since the composition and microstructure of austenite and martensite of the stainless steel pipe is

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similar to the composition and microstructure of austenite and martensite of the instant invention and since the pipe is made using a similar method, one of ordinary skill in the art would expect the stainless steel seamless pipe of JP '009 to have a similar volume fraction of ferrite phase. See MPEP 2112. Applicant has not provided evidence to show that the stainless seamless steel pipe of JP '009 is materially different from the pipe of the instant invention.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

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